



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

41

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,719	03/08/2001	Scott S. Ingraham	2043.207US1	7887
49845	7590	05/29/2007		
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER FELTEN, DANIEL S	
			ART UNIT 3693	PAPER NUMBER
			NOTIFICATION DATE 05/29/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWK.COM

## Office Action Summary

**Application No.**

09/802,719

**Applicant(s)**

INGRAHAM ET AL.

**Examiner**

Daniel S. Felten

**Art Unit**

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Receipt of the amendment filed March 01, 2007 amending claims 1, 3-5, 9-19, 21, 22, 24-30, 37-43 and 47 is acknowledged. Claims 1-47 remain pending in the application and are presented to be examined upon their merits.

### ***Response to Arguments***

2. Applicant's arguments filed March 01, 2007 have been fully considered but they are not persuasive. In response to applicant's arguments, the recitation of a *computer-implemented* method has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, it is maintained that the § 101 rejection of the claims is proper because the body of the claims may stand alone as a manual process without the use of a computer. Thus, because there is no dependent step(s) that tie the body of the claim to the preamble (e.g., a recitation of a computer within the body of the claim), the § 101 rejection of claims 1-19 in the December 01, 2006 is maintained.

In regards to the applicant's assertions that the December 01, 2006 Office Action failed to make a prima facie case of obvious, the examiner disagrees. The applicant is respectfully reminded that references in determining obviousness are not read in isolation but for what they fairly teach in combination with the prior art as a whole, and thus the applicant's reference-by-

Art Unit: 3693

reference attack on prior art to demonstrate non-obviousness is not persuasive [(see Photectrice sensing system) Banner Engineering v. Tri-Tronics Co. Inc., 29 USPQ 1392 1389 (CAFC 1993 unpub) citing in re Merck, 231 USPQ 375 (CAFC 1986)].

In regards to the assertion that Fraser does not teach “*receiving a transaction request from a requesting party*” or “*matching the transaction request with the plurality of property profiles*,” as recited in claims 1, 20 and 34, the examiner disagrees. The applicant is requested to read Fraser, column 6, line 32 to column 8, line 12). In Fraser’s system, buyers can create purchase orders (or transactions requests) that are stored in Fraser’s system as an electronic document to purchase goods or services from appropriate sellers (see column 6, lines 32+) . The Examiner interprets in this case that the requesting party can be either the buyer or the seller which provides Fraser’s system with requirements needed by either the buyer or the seller. Further in regards to the matching feature, Fraser mentions that there are terms and criteria associated with the purchase order (transaction request), that is used for “filtering” the purchase order against the appropriate goods and services. It is being interpreted that Fraser’s filtering of the purchaser order provides Fraser’s system with the ability to match the purchase order (transaction request) with criteria provided by the sellers. In this case it is being maintained that the system comparing criteria against terms is equivalent to matching (see column 6, lines 60 to column 7, lines 5). Thus the terms are being considered property profiles and the filtering feature of Fraser being considered and being provided to the responsible party. Thus rejections using Fraser and Tozzoli is maintained

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-10, 12-14, 17-20, 22-25, 27-28, 31-40, 42 and 44, 45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser (US 5,664,115) in view of Tozzoli et al (US 5,717,989)

Fraser discloses a computer implemented method receiving a plurality of property profiles from a plurality of responsible parties (see Abstract, column 4, lines 17-23; and column 5, lines 11-15), *as in claims 1, 20 & 34*

--receiving at least one transaction request from at least one requesting party(see column 7, lines 34-37), *as in claims 1, 20 & 34*

--matching the transaction request with the property profiles(S107)(see column 6, lines 40-48), *as in claims 1, 20 & 34*

--a machine readable medium having stored thereon instructions which when executed by a processor cause the machine to perform operations (see column 4, lines 61-67), *as in claim 20*

Fraser fails to disclose, providing the transaction request to the responsible parties of those properties that match the transaction request.

Tozzoli discloses a matching system where a buyer provides terms of a transaction to selected sellers based upon certain criteria (see Tozzoli, column 7, lines 11-33).

Art Unit: 3693

It would have been obvious for an artisan at the time the invention to modify the matching system of Fraser to provide the transaction request to the responsible parties as disclosed in the matching system of Tozzoli to allow sellers to accept, reject and/or change criteria so as to further matching and/or negotiations between buyer and sellers. Thus such a modification would be an obvious expedient well within the scope of the art.

--a bus (6), (see column 4, lines 6+)

--a storage device coupled to the bus (see column 4, lines 6+);

--a processor (CPU) coupled to the bus, the processor to execute software to cause the computer to perform operations comprising (see fig. 2, column 4, lines 43-67)

Fraser fails to disclose, as in claims 5 and 22, an offer received from at least one of the responsible parties to at least one of the requesting parties. Tozzoli discloses that the responsible parties are able to make offers to the requesting parties (see Tozzoli, column 7, lines 26-33). It would have been obvious to modify Fraser to allow an offer to be submitted from the responsible parties to the requesting parties, as described in Tozzoli, to further provide the Fraser invention with the ability for sellers to communicate and negotiate better terms with potential buyers. Thus such a modification would be considered an obvious expedient well within the ordinary skill of the art.

Fraser discloses, as in claims 8 and 23, a ranking based upon a plurality of criteria (see Fraser, "property listing", Abstract), but fails to disclose that the ranking is part of an offer. Tozzoli discloses ranking based upon an offer and certain criteria/terms (see Tozzoli, column 7, lines 10-33). It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Fraser to provide ranking of criteria based upon offers so as to communicate

Art Unit: 3693

to sellers how much the buyer would be willing to pay for a particular property having certain features. From normal business practice between buyers and sellers in a negotiation process, one would expect buyers to favor certain features over others. Thus such modification would be an obvious expedient well within the ordinary skill in the art.

--receiving at least one unit information (see Fraser, column , lines ), *as in claims 18, 32 and 45*

--wherein the matching engine is performed by a matching engine (S107), (see Fraser, fig. 5B, column 6, lines 41-48), *as in claim 35*

--wherein the matching engine comprises of a plurality of software instructions, (see Fraser, fig. 3, column 5, lines 1-15) *as in claim 36*

Fraser fails to disclose, *as in claims 9, 24 and 37*, providing acceptance received from one of the requesting parties to one of the responsible parties.

Tozzoli discloses providing acceptance received from one of the requesting parties to one of the responsible parties, (see column 7, lines 26-33).

It would have been obvious for an artisan of ordinary skill in the art at the time of the invention was made to modify Fraser to provide an acceptance received from one of the requesting parties to one of the responsible parties to allow further communication and interaction/ interactivity between the buyer and the seller. Thus such a modification would further provide an indication of properties that would be filter or weeded out of the system (see column 10, lines 1-24). Such a modification would be an obvious expedient well within the ordinary skill of the art.

Art Unit: 3693

7. Claims 14, 19, 29, 33, 41, 42 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser (US 5,664,115) as modified by Tozzoli et al (US 5,717,989) as applied to claim 1 in further view of Broerman (US 6,594,633)

--Fraser as modified by Tozzoli discloses billing the responsible party a listing fee, but fails to disclose billing the responsible parties a success fee. Broerman (US 6,594,633) teaches a success fee (see column 7, lines 21-25; also see "sales verification", lines 54+), as in claims 14, 19, 29, 33, 42, 46. The sales verification, as taught in Broerman would have been an obvious extension to the teaching of Fraser as modified by Tozzoli in as much as one of ordinary skill in the art would seek to provide a verification of sale so as to indicate that a match and/or transaction had transpired.

--Fraser as modified by Tozzoli fails to disclose providing a property visit request received from one of the requesting parties. Broerman discloses providing a property visit request (see column, 8, lines 9-19; and column 8, lines 31-38), *as in claims 10, 25 and 38.*

In buying and/or renting a property it is customary for the buyer to ask the seller/rentor to inspect the property before making a final decision on whether not to buy and/or actually rent the property. This concept is called, "Due diligence." In conventional business practice, it is conventional for a buyer/renter to perform due diligence by requesting a visit of the property to ensure that the property is what the seller/rentor has advertised the property to be and that the criteria of the buyer is met.

Thus it submitted that requesting a visit of the property would be an obvious extension to the teachings of Fraser as modified by Tozzoli to ensure criteria of the buyer is met.

Art Unit: 3693

--Fraser as modified by Tozzoli discloses a notification receiving lease execution notification from at least one of the responsible parties, (see column 8, lines 8-19; and also column 8, lines 31-38), *as in claims 12, 28 and 41*,

--receiving sale execution notification from at least one of the responsible parties, (see column 8, lines 8-19; and also column 8, lines 31-38), *as in claims 13, 28, 41*,

--providing a sequence of maps to prompt the requesting party to select at least one desired geographical location, (see column 8, lines 20+), *as in claims 17, 31 and 44*

8. Claims 2, 11, 21, 26 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser (US 5,664,115) as modified by Tozzoli et al (US 5,717,989) and Broerman (US 6,594,633) as applied to claim 1 in further view of over in view of Walker et al (US 5,884,272)

Fraser as modified by Tozzoli and Broerman discloses hiding parts of the criteria used to filter buyers and sellers during the negotiation/filtering process, but fails to disclose anonymous communications such that an identity of the requesting party is hidden from the responsible party, *as in claims 2, 11, 21, 26 and 39*.

Walker discloses a discloses a system for establishing anonymous communications between parties ( see Walker, Abstract, column 4, lines 19-27).

Walker discusses several motivations why one of ordinary skill in the art would seek anonymous communications (see Walker, column 1, line 36 to column 4, line 13; and column 4, lines 16 to column 6, line 23)

Art Unit: 3693

The anonymous features disclosed in Walker would have been obvious to extensions of the teachings of Fraser as modified by Tozzoli and Broerman to ensure the privacy of pertinent information associated with either the buyer and/or the seller. Thus such a modification would allow both parties to feel comfortable with the transaction. Thus such a modification would be considered an obvious expedient well within the ordinary skill in the art.

9. Claims 15, 16, 30 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser (US 5,664,115) as modified by Tozzoli et al (US 5,717,989) and Broerman (US 6,594,633) in further view of Eggleston et al (US 6,061, 660)

Fraser as modified by Tozzoli et al and Broerman fails to disclose receiving a request for a promotional reward from at least one of the requesting parties, *as in claims 15, 16, 30, and 43*

Eggleston disclose a method and system for providing programs over the Internet to offer incentive programs to customers (see Eggleston Abstract). It would obvious to combine Broerman and Eggleston to promote usage of the Fraser as modified by Tozzoli et al and Broerman over the Internet as well as increase sales as enunciated in the background of Eggleston (see Eggleston column 1, lines 27+). Thus such a modification would increase the amount of use of the Broerman invention and thus be an obvious expedient to one of ordinary skill in the art.

***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3693

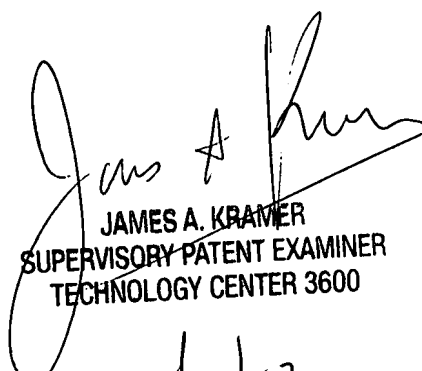
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel S Felten  
Examiner  
Art Unit 3693



DSF  
05/14/2007



JAMES A. KRAMER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600  
5/21/07